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REMARKS

Claims 1-20 were originally presented in the subject application. No claims have herein been added, canceled or amended. Therefore, claims 1-20 remain in this case.

Applicants respectfully request reconsideration and withdrawal of the grounds of rejection and objection.

35 U.S.C. §102(b) Rejection***Kotner***

The Office Action rejected claims 1, 2, 4, 6 and 12-19 under 35 U.S.C. §102(b), as allegedly anticipated by Kotner (U.S. Patent No. 1,085,212). Applicants respectfully, but most strenuously, traverse this rejection.

Claim 1 recites a hair clip, comprising a plurality of finger, each having a first tip end and a second base end, the fingers lying adjacent each other side by side in a single plane, each finger linked to an adjacent finger by a hinge means located proximate the second end of each finger. The first tip ends of the fingers may be opened or closed with respect to each other. Claim 1 further recites a tensioning means located proximate the second base end, the tensioning means biases the first top end of the fingers in a closed position.

Applicants submit that Kotner fails to disclose, teach or suggest, for example, *each* finger linked to an adjacent finger by a hinge means located proximate the second end of each finger. Instead, only the two inner prongs 9 and 10 are connected by a spring; the two outer prongs 6 are stationary. Neither of the outer prongs is linked to its adjacent inner prong by any sort of hinge means.

As another example, Applicants submit that Kotner fails to disclose, teach or suggest, the first tip ends of the fingers may be opened or closed with respect to each other. Applicants submit the two inner prongs do not open/close with respect to each other; in fact, just the opposite. When blocks 11 and 12 are pressed (see Kotner FIG. 2), inner prongs 9

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and 10 move inward toward each other. When the Kotner hair pin is opened, the two inner prongs move toward each other and away from the outer prongs 6, and when the hair pin is closed (see Kotner FIG. 1), the two inner prongs move away from each other toward the outer prongs. Thus, when the inner prongs of Kotner are opening or closing, they are doing the opposite with respect to the outer prongs. In contrast, as shown in FIGs. 1 (closed) and 2 (open) of the present application, the tip ends of all the fingers of the hair clip move toward each other when closed and away from each other when opened.

Therefore, Applicants submit that claim 1 cannot be anticipated by or made obvious over Kotner.

Applicants submit that the rejected dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, claim 6 recites that each of the intermediate fingers have an opening therethrough proximate the second end and in line with the opening in adjacent fingers, wherein the tensioning means is positioned through the adjacent openings in the intermediate fingers.

In contrast, the spring 13 of Kotner sits within recess 7 of blocks 11 and 12 (see FIGs. 1 and 2), and not in openings through fingers, as claimed in claim 6.

Therefore, Applicants submit that claim 6 cannot be anticipated by or made obvious over Kotner.

As another example, claim 16 recites that at least the outermost fingers have handles proximate the second ends of the fingers.

Although the Office Action does not specifically discuss any particular claim, it does allege at page 2 that Kotner discloses "[t]he outermost fingers each having a detachable handle (11, 12) proximate the second end of the finger." However, it is clear from Kotner at

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column 2, lines 69-72 and 91-95, and best shown in FIG. 1 thereof, that blocks 11 and 12 are integral with inner prongs 9 and 10, and not outer prongs 6. Even if one assumes, *arguendo*, that blocks 11 and 12 can be considered handles, the blocks are not associated with at least the outermost prongs.

Therefore, Applicants submit that claim 16 cannot be anticipated by or made obvious over Kotner.

As yet another example, claim 18 recites that each of the fingers has a handle proximate the second end of the finger.

However, as submitted above with respect to claim 16, the cited blocks 11 and 12 are connected to inner prongs 9 and 10 of Kotner. There are no "handles" associated with outer prongs 6.

Therefore, Applicants submit that claim 18 cannot be anticipated by or made obvious over Kotner.

As still another example, claim 19 recites that the handles are removable or detachable. The cited blocks 11 and 12 are neither removable nor detachable; rather, they are integral with inner prongs 9 and 10, as best shown in FIG. 1 of Kotner.

Therefore, Applicants submit that claim 19 cannot be anticipated by or made obvious over Kotner.

Erstling

The Office Action rejected claims 1, 5 and 7-11 under 35 U.S.C. §102(b), as allegedly anticipated by Erstling (U.S. Patent No. 792,887). Applicants respectfully, but most strenuously, traverse this rejection.

The Office Action alleges that the Erstling comb is inherently used as a hair clip, citing FIG. 2 thereof.

The doctrine of inherency is well-settled in patent law, and is best described in an excerpt from *Hansgirk v. Kemmer*, 26 C.C.P.A. 937, 102 F.2d 212, 40 U.S.P.Q. 665 (1939):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [citations omitted.] If, however, the disclosure [of the cited reference] is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient [to anticipate the claimed invention].

Id. at 940, 102 F.2d at 214, 40 U.S.P.Q. at 667; *Stoller v. Ford Motor Co.*, 18 U.S.P.Q.2d 1545, 1547 (Fed. Cir. 1991); *Tyler Refrigeration v. Kysor Industrial Corporation*, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.L. 1990); *In re Oelrich and Divigard*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In *Ex parte Levy*, the court stated that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d at 1464 (lengthy citation omitted) (underlining added).

Applicants submit that the required basis in fact and/or technical reasoning is wholly absent from the Office Action. Thus, Applicants submit that the Office Action fails to present even a *prima facie* case of inherency.

Moreover, Erstling teaches only that the comb is opened as in FIG. 2 so as to allow for cleaning thereof. See Erstling at column 2, lines 84-93. There is no teaching or suggestion of using the ability to open the comb to function as a hair clip. There is no reason to believe from Erstling, for example, that the comb is even constructed such that it would not break from use as a hair clip, or that it could even be closed with such an obstruction. In fact, since the teeth can be freely rotated, as shown in FIG. 2, and described in Erstling at

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column 2, lines 91-92, Applicants submit that this feature would actually discourage, if not make impossible, the use of the comb as a hair clip.

Therefore, Applicants submit that it is not inherent to use the comb of Erstling as a hair clip.

In addition, Applicants submit that Erstling is improperly cited against the present application as non-analogous art.

The determination that a reference is non-analogous art involves two steps. *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc.*, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994); *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171, 174 (CCPA 1979). First, the reference is reviewed as to whether it is within the field of the Applicants' endeavor. *Id.* Second, if the reference is not in the field of endeavor, then a determination is made as to whether the reference is reasonably pertinent to the particular problem the inventor sought to solve. *Id.*

In determining what the field of endeavor is, courts have looked to the field of endeavor set out in a patent or patent application. See, e.g., *In re Wood and Eversole*, 202 U.S.P.Q. 171 (CCPA 1979).

In the present case, the field of endeavor is set out generally as hair dressing and hair fashion, and in particular, to a hair clip that comprises a plurality of fingers. Erstling is directed to a comb with accessible teeth for cleaning and replacement. Applicants submit that it is not enough for both to be generally directed to hair implements. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993) (that art cited against claims to particular type of memory relates to memory generally is not enough to be analogous). Therefore, Applicants submit that Erstling is not within the field of Applicant's endeavor.

We next turn to whether Erstling is reasonably pertinent to the problem the present invention seeks to solve. The problem set out is the inadequacy of prior art hair clips in

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several respects: not capable of holding a plurality of strands or bunches of hair; only capable of holding hair over a narrow distance on the head; not capable of gripping the hair, propping it up and promoting it to stand away from the head adjacent the hair roots, while allowing the loose ends of the hair to fall naturally. See the present application at page 1, paragraphs 3 and 4.

Applicants submit that the comb of Erstling is not reasonably pertinent to the above-noted problems. Applicants submit that the purpose of a comb is to groom hair, not to hold hair as a hair clip does. In addition, the object of Erstling is set out as providing a comb adapted to facilitate cleaning and replacement of the teeth. These objects are not reasonably pertinent to the above-noted problems sought to be solved by the present invention.

Therefore, Applicants submit that Erstling is improperly cited against the present invention as non-analogous art.

Objection to Claims

The Office Action objected to claim 3 as depending from a rejected base claim. However, the Office Action also indicated that claim 3 would be allowable if amended in independent form, including all of the limitations of the base claim and any intervening claims.

Although Applicants sincerely appreciate the indication of allowable subject matter, in light of the remarks made above with respect to the substantive rejections, Applicants respectfully decline to so amend claim 3 at this time. However, Applicants reserve the right to do so at a later point in prosecution.

CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

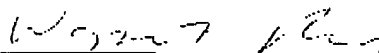
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Applicants acknowledge the references cited in the Office Action, but not substantively applied. However, Applicants submit that the pending claims are patentable thereover as well.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1-20.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.



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